

REMARKS

Claims 3-4, 7-10, and 16-18 are pending and under consideration. Claims 16-18 have been amended. Applicants wish to thank the Examiner for participating in the case interview, during which, Applicants argued that Ogawa does not disclose, "a second searching unit," as identified by the language of claim 16, for example.

On page 2 of the current Office Action, claim 18 was rejected under 35 U.S.C. § 101 due to the claimed invention being directed to non-statutory subject matter. In particular, the Examiner alleged that "a computer-readable storage medium" does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. § 101.

Applicants respectfully submit that it is almost axiomatic that a computer-readable storage medium is considered patentable subject matter under 35 U.S.C. § 101. Applicants further submit that the rejection is without merit and has no foundation within U.S. Patent Law.

As clearly indicated in the Manual of Patent Examining Procedure (MPEP), "a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory." See MPEP, 2106.01(I). See also *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

As instructed by the Manual of Patent Examining Procedure, USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim.

In the present application, claim 18 recites a, "computer-readable storage medium storing a program for execution on a computer. . . ." The claim further recites, "a storage unit" and "a first searching unit," among other elements. In light of the foregoing, Applicants respectfully submit that claim 18 is directed to patentable subject matter. As the rejection has no foundation within U.S. Patent Law, withdrawal of the rejection is respectfully requested.

On page 3 of the Office Action, claims 16-18 were rejected under 35 U.S.C. § 112, first paragraph, due to the claims allegedly not being enabled. The Examiner stated that, "[t]he first telephone number is stored in a first backup copy and a second telephone number stored in a second backup copy." Applicants respectfully submit that the statement is incorrect. The first and second telephone numbers refer to telephone numbers used to call the first and second

subscribers, respectively. In independent claims 16-18, the first telephone number is stored in a second backup copy, and the second telephone number is stored in a first backup copy. Therefore, the claim features reciting the searching of the second backup copy for the first telephone number is consistent with the other parts of the claim.

Applicants have amended the claims to clarify the operations. In particular, the claims have been amended to include the recitations, "a first subscriber identified by a first telephone number" and "a second subscriber identified by a second telephone number."

Applicants respectfully submit that the specification satisfies the enablement requirement for the subject matter of claims 16-18 by providing a sufficient disclosure on page 14, line 15 – page 17, line 1, as well as FIGS. 16-19. Withdrawal of the rejection is respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: 

Reginald D. Lucas
Registration No. 46,883

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501